

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN MALTBY,
SIMON PHIPPS,
and VINCE SINGLETON

Appeal No. 1997-3433
Application 08/395,548¹

ON BRIEF

Before KRASS, MARTIN, and BARRETT, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

¹ Application for patent filed February 28, 1995, entitled "Object Linking And Embedding Over A Computer Network," which claims the foreign filing priority benefit under 35 U.S.C. § 119 of United Kingdom Application 9405757.7, filed March 23, 1994.

Appeal No. 1997-3433
Application 08/395,548

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-10.

We reverse.

BACKGROUND

The invention is directed to a method of providing object linking and embedding (OLE), more specifically, just object embedding, between two computers on a network each running a stand-alone operating system supporting a clipboard.

Claim 1 is reproduced below.

1. A method of providing object linking and embedding (OLE) over a computer network, in which an object generated by an arbitrary first application at a first computer in the network may be incorporated into an arbitrary second application at a second computer in the network, said first and second computers each running a stand-alone operating system supporting a clipboard, the method comprising the steps of:

receiving notification that the first application has submitted material to the clipboard on the first computer and obtaining a list of available formats for said submitted material;

transmitting the format(s) corresponding to Object Embedding to the second computer;

submitting the format(s) corresponding to Object Embedding to the clipboard at the second computer for selection by the second application.

Appeal No. 1997-3433
Application 08/395,548

The Examiner relies on the following prior art references:

Thessin et al. (Thessin) 5,452,299 September 19,
1995
(filed October 14,
1993)

Object Linking & Embedding, Microsoft Corporation,
November 6, 1991, pages 1-45 (hereinafter "Microsoft
OLE").

Orfali et al. (Orfali), Client/Server Survival Guide with OS/2, Van Nostrand Reinhold, 1994, pages 745-753.

Claims 1-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Thessin, Microsoft OLE, and Orfali.

We refer to the Final Rejection (Paper No. 7) (pages referred to as "FR__") and the Examiner's Answer (Paper No. 15) (pages referred to as "EA__") for a statement of the Examiner's position and to the Appeal Brief (Paper No. 14) (pages referred to as "Br__") for Appellants' arguments thereagainst.

OPINION

Thessin relates to electronic teleconferencing and, more specifically, to mechanisms for communicating and synchronizing data among a plurality of software agents, each agent being on a computer of a participant. The software

organization of an agent is shown in figure 2. At least four different types of "annotations" can be used to exchange information during the conference (col. 8, lines 19-47):

(1) drawing annotations; (2) graphic annotations; (3) textual annotations; and (4) OLE annotations. The Examiner relies on the OLE annotation, which is described at column 8, lines 35-47:

One other annotation which may be used in one embodiment of the present invention is the OLE annotation using the Object Linking and Embedding (OLE) protocol available from Microsoft Corporation of Redmond, Wash. OLE annotations may reference other "objects" created and/or maintained by other application programs and which may be either linked or embedded using OLE. Each of these annotations is stored as an object under an "annotation" classification which is associated with objects in the page classification. FIG. 5 illustrates the classification for objects used in one embodiment of the present invention.

The Examiner also points to Thessin, column 9, lines 13-23:

One other annotation which may be used in one embodiment of the present invention is the CCOLEAnnotation class 520 which is part of the COLEDocument classification 503 for performing object linking and embedding using the Object Linking and Embedding (OLE) protocol available from Microsoft Corporation of Redmond, Wash. Annotations may, thus, be references to "objects" created and/or maintained by other application programs and which may be either linked or embedded using OLE.

Although not mentioned by the Examiner, Thessin describes transferring a type of data object known as a very Binary

Appeal No. 1997-3433
Application 08/395,548

Large Object or "BLOB" where "BLOB's [sic] typically comprise items such as very large graphic data, OLE annotations or files to be transferred" (col. 13, lines 63-65).

Thessin discloses transferring OLE annotations, but, aside from the agent structure in figure 2, does not disclose the mechanism for transferring an OLE annotation from a first computer to a second computer. Nevertheless, the Examiner finds (FR4-5):

Thessin et al. explicitly teach the well-known OLE protocol [col. 8, lines 35[-]47, col. 9, lines 13 - 23], hence, Thessin et al. inherently teach the following steps of:

! receiving notification that the first application has submitted material to the clipboard on the first computer and obtaining a list of available formats for said submitted material [col. 8, lines 35[-]47, col. 9, lines 13 - 23];

! transmitting the format(s) corresponding to Object Embedding to the second computer [col. 8, lines 35[-]47, col. 9, lines 13 - 23];

! submitting the format(s) corresponding to Object Embedding to the clipboard at the second computer for selection by the second application [col. 8, lines 35[-]47, col. 9, lines 13 - 23].

However, **Thessin et al.** do not explicitly disclose using the clipboard to transmit and submit the format(s) corresponding to Object Embedding for selection by an application.

Appellants argue that Thessin does not teach the three steps which the Examiner finds to be inherent (Br8-11). It is clear that column 8, lines 35-47, and column 9, lines 13-23, say nothing about the three steps which the Examiner finds to be inherent, but only refer to OLE. In response to Appellants' arguments that Thessin does not teach the three steps, the Examiner brings in Microsoft OLE, which discusses data formats and the clipboard for OLE on a single computer (EA9-11, responding to arguments A1 to A3). Thus, the Examiner has changed the rejection by changing how the references are combined and applied. The intended rejection is now based on how one of ordinary skill in the art would have interpreted the OLE references in Thessin given the OLE teachings contained in Microsoft OLE. Appellants correctly observe that "[t]he natural combination of Thessin et al. with the Microsoft OLE reference therefore simply produces the same system as already described in Thessin et al., with the Microsoft OLE reference available to flesh out some of the details omitted from Thessin et al. ..." (Br12). Appellants provide a description of Thessin in Figure C of the Attachment to the Brief. "The depiction of Figure C is based on the

Appeal No. 1997-3433
Application 08/395,548

explicit teachings in Thessin et al., together with general information on OLE (e.g. as per the Microsoft Object Linking and Embedding reference)." (Br6.) Therefore, Appellants address the combination that should have been made.

Appellants' description of the teachings of Thessin together with Microsoft OLE in Figure C of the Attachment and Table C (Br7) is considered a very fair summary and goes beyond what is readily apparent from Thessin. We appreciate Appellants' candor and the work it took to prepare these comparison figures. We analyze claim 1 by comparison to Figure C and Table C.

The step of "receiving notification that the first application has submitted material to the clipboard on the first computer" is very broad, as appreciated by the Examiner (EA9). In our opinion, the clipboard itself satisfies this step because it knows when material has been submitted. We do not agree with Appellants' argument (Br9) that the step of "receiving notification" requires the clipboard to perform a step of "sending notification" to the conferencing software (as shown in arrow 2 in Figure A of the Attachment) or elsewhere. "Receiving notification" could be in response to

Appeal No. 1997-3433
Application 08/395,548

an inquiry from the agent, e.g., in response to a "callback" from the conference manager to the object manager to determine what objects have been added (col. 6, lines 38-45), where the object manager is in communication with the clipboard. We also do not agree with Appellants' argument that "the claimed step of notifying is part of communicating to the user of the second machine that there is new material on the clipboard at the first machine (otherwise they would not be aware of the existence of this new material)" (Br9) because: (1) claim 1 does not specify what entity receives the notification, so it could be just the clipboard that receives notification; and (2) Appellants' own Figure A of the Attachment shows notification being received by the conferencing software P2P-A, not by the other computer.

Appellants admit that Thessin discloses the step of "obtaining a list of available formats for said submitted material" as shown in arrow 3.

What is not admitted to be taught is the step of "transmitting the format(s) corresponding to Object Embedding to the second computer." Instead, Thessin discloses transmitting only the data object itself (e.g., col. 13,

lines 55-67). In response to Appellants' argument (Br9-10) that Thessin (taken together with Microsoft OLE) does not teach the transmitting step, the Examiner merely points to statements in Microsoft OLE about putting the preferred data formats on the clipboard (EA10). This does not respond to the arguments. Appellants note that in a telephone interview, "the Examiner explained that he interprets the transmission of data itself in Thessin et al. as inherently transmitting the format corresponding to the data" (Br9). The Examiner's Interview Summary states that "[t]he Examiner clarified his interpretation of the scope of data 'format'" (Paper No. 11), but does not state what that interpretation is.

We agree with Appellants' arguments that the Examiner's position is untenable for the reasons enumerated at pages 9-10 of the Brief, which need not be repeated. The last reference to Orfali is not applied to show the step of "transmitting the format(s)," but we consider its teaching.

The Examiner states (FR6; EA5): "Orfali et al. discloses that an object generated by an *arbitrary* first application at a first computer in the network may be incorporated into an *arbitrary* second application at a second computer in the

Appeal No. 1997-3433
Application 08/395,548

network [p 754, 755]." Appellants respond that Orfali is an announcement of future intent and provides no details how to implement distributed OLE. Appellants note that Orfali states (page 755): "We still don't know how these distributed OLE objects will be stored, located, secured, replicated, and managed."

We agree with Appellants that Orfali does not disclose any details of distributed OLE that would cure the deficiencies of Thessin and Microsoft OLE with respect to the step of "transmitting the format(s)." Accordingly, we conclude that the Examiner has failed to establish a prima facie case of obviousness. The rejection of claim 1 and dependent claims 2-10 is reversed.

What is also not admitted to be taught is the step of "submitting the format(s) corresponding to Object Embedding to the clipboard at the second computer for selection by the second application." It is argued that the operation of Thessin does not involve a clipboard on the second computer at all and there is no selection of a format on the second computer because the object is automatically embedded into Agent B (Br11). We agree. Orfali does not cure the

Appeal No. 1997-3433
Application 08/395,548

deficiencies of Thessin and Microsoft OLE with respect to this limitation. For this additional reason, the rejection of claims 1-10 is reversed.

CONCLUSION

The rejection of claims 1-10 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative	Patent Judge)
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)	BOARD OF PATENT
JOHN C. MARTIN)	APPEALS
Administrative	Patent Judge)
)	AND
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Appeal No. 1997-3433
Application 08/395,548

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